

Information Disclosure Statement

Applicant greatly appreciates Examiner Lashley's clarification expressly instructing Applicant to provide new copies of the non-patent literature reference[s] cited in the February 6, 2007 IDS, specifically "Caronni, Germano: Assuring Ownership. ...". To more fully comply with the Office's instructions, Applicant has provided new copies of the cited reference[s], with an updated IDS, confirmed during the Interview[s]. Second, Stringer is not admitted prior art. As will be presented below, Stringer cannot be characterized as prior art, as that term is understood. Please see, for instance, MPEP § 2129 [cited here for reference]:

Mere listing of a reference in an information disclosure statement is not taken as an admission that the reference is prior art against the claims. *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354-55, 66 USPQ2d 1331, 1337-38 (Fed Cir. 2003) (listing of applicant's own prior patent in an IDS does not make it available as prior art absent a statutory basis); see also 37 CFR 1.97(h) ("The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b).").

Rejections under 35 U.S.C. § 103

In order to "establish a prima facie case of obviousness, three basic criteria must be met." MPEP § 706.02(j):

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. 'To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness to the extent that the citations do not teach or suggest all of the claim elements. The arguments in connection with Bond are cited above.

Second, there is no motivation or suggestion to make the proposed combinations of the citations as directed by the Office. More particularly, there is no motivation to combine Bond with Stringer. The Federal Circuit has emphasized the importance of providing evidence of motivation to combine in *Winner Int'l Royalty Corp. v. Ching-Rong Wang*, 202 F. 3d 1340, 1348-49 (Fed. Cir. Jan. 27, 2000). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another . . . the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" *Winner*, 202 F. 3d at 1348-49 (citations omitted). Further, the "absence of such a suggestion to combine is dispositive in an obviousness determination." *Gambro Lundia AB v. Baxter Healthcare Corp.*, 11 F.3d 1573, 1579 (Fed. Cir. 1997).

Instead, it appears that the Office Action identifies citations without reference to the elements of the claims, and has combined them. Even assuming *arguendo* that the references contained all elements of the claimed invention, it is still impermissible to reject a claim that would *allegedly* have been obvious simply "by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done." *Ex parte Levengood*, 28 USPQ2d 1300, 1303 (Bd. Pat. App. & Inter. 1993) [emphasis added]. Applicant submits that the Office has not satisfied the initial burden "to provide some suggestion of the desirability of doing what the inventor has done" MPEP § 706.02(j).

Third, Applicant respectfully raises the question of whether the cited references can be interpreted as analogous. The pending claims are of a pioneering nature while the cited references are arguably dissimilar in both structure and function as argued by the Office Action. Particularly, "controlling access to digital data", non-final Office Action dated January 22, 2008 at Page 11, is unclear. Please see MPEP § 2141.01, cited here for convenience:

2141.01(a) Analogous and Nonanalogous Art [R-6]

I. TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE ANALOGOUS PRIOR ART

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. **>"Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed. " *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007). Thus a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole.<

II. **>CONSIDER< SIMILARITIES AND DIFFERENCES IN STRUCTURE AND FUNCTION **

While Patent Office classification of references and the cross-references in the official search notes of the class definitions are some evidence of "nonanalogy" or "analogy" respectively, the court has found "the similarities and differences in structure and function of the inventions to carry far greater weight." *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) (The structural

similarities and functional overlap between the structural gratings shown by one reference and the shoe scrapers of the type shown by another reference were readily apparent, and therefore the arts to which the reference patents belonged were reasonably pertinent to the art with which appellant's invention dealt (pedestrian floor gratings).).**

Last, *for argument's sake*, even if the claim elements did teach or suggest all of the claim elements there is no reasonable expectation of success in combining the citations as suggested by the Office Action. The suggested combination[s] are not a "predictable use of prior art elements according to their established functions" (*KSR* Opinion at Page 13). Additional discussion will be presented below. For at least these reasons, Applicant respectfully requests the Section 103 rejections of Claims 8, 11 & 13-21 be withdrawn.

1. a) 35 USC § 103(a) Rejections based on U.S. Patent No. 4,390,898 issued to Bond et al. ("Bond") in view of U.S. Patent No. 5,341,429 issued to Stringer et al. ("Stringer") as applied to Claims 8, 11 & 13-21

Claims 8, 11 & 13-21 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bond in view of Stringer. As stated previously, Stringer is not "admitted" prior art and cannot be characterized as prior art, as that term is understood. Office Action states [emphasis in original]:

... Stringer however does disclose wherein the predetermined key comprises a plurality of mask sets (see column 4, lines 10-14: interfering material...mask...; column 9, lines 18-20) Bond and Stringer are analogous art because they are from the same problem solving area (controlling access to digital data). At the times of the invention, it would have been obvious to a person of ordinary skill in the art to modify the digital data (video signal) as in Bond such that it would incorporate mask sets as in Stringer. The motivation for doing so would have been to improve the security and authenticity of the digital data.

Applicant respectfully traverses. The references do not disclose or suggest key creation, let alone "mask set", as claimed. In fact, Stringer expressly discloses a "mask" as "... added to the original material" (Stringer at Col. 4 ll. 10-11) – not the "mask set[s]" of the claims. Without conceding the propriety of the asserted combination, Applicant submits that the asserted combination does not disclose at least the following feature of independent claim 6, among other features, "creating a predetermined key", for at least the following reasons, Bond apparently teaches encrypting "separate information", not the video itself, to make said video "unwatchable". Similar to claim 6, pending independent claim 20 similarly recites, "creating a predetermined key comprising a mask set".

Stringer is cited for its alleged disclosure of various features of claim 6 and claim 20. Applicant respectfully submits that Stringer does not add anything to Bond that would remedy the deficiencies cited above. Bond allegedly teaches *unwatchable* data with encrypted "separate information". Stringer's denaturing wrapper is *not* a "mask set" as contended in the Office Action. In fact, Stringer teaches away from the claim[s] by disclosing "denaturing" of material with wrappers. For example Stringer at Col. 6 ll. 1-11 recites [emphasis added]:

'Wrapper'. Allows remote transaction to control bidirectional transformation between the original, evaluation, and trial versions of the material.

The preferred embodiment of the present invention converts and

encrypts any desired software products using a 'denaturing' process that replaces a portion of the product information, such as a standard version of an application program's "start-up" code, with a special portion, e.g. a special start-up code segment, that links the product to a usage counter and encrypts the application.

Next, in contrast with the claims, Stringer's alleged "watermark" is *not the watermark of the claims as understood in view of the specification and originally filed claims*. As is understood by one of ordinary skill in the art, Stringer apparently discloses copyright notices in full view. Of additional significance, Stringer expressly teaches *removing* his alleged watermarks, again teaching away from the claims, - Stringer at Col. 7 ll. 48-57:

For example, denaturing material M2 (15) could include a watermark or copyright notice that is inserted into the original material by function F2 (19). To remove the watermark or other material and enable unlimited use of the material, the denatured version of the original material is subjected, for example, to exclusive-or operation with the denaturing material (either by function F1 or F2), or any other technique that would serve to erase the watermark from the original material.

Second, the Office has not presented "clear and particular" evidence of a motivating force. The Office Action appears to identify citations that allegedly disclose elements of the claims. This gives rise to impermissible hindsight, as there is clearly no motivation to combine Bond and Stringer. Even assuming, *for argument's sake*, there was a motivation to make the proposed combination of Bond and Stringer, the combination fails to disclose or suggest all of the terms of independent claim 6 (and all claims depending therefrom) and independent claim 20 (and all claims depending therefrom). Combining Bond and Stringer would be improper as Bond's "unwatchable" video requires "separate information" that is independently encrypted. Stringer "denatures" media with wrappers. Again, this teaches away from making *keyed signals* available to encourage broader access to information. In fact, the combination of Bond and Stringer would likely increase the computational complexity of distributing "unwatchable", wrapped, "denatured" data without any established benefit.

Third, there is no reasonable likelihood of success. Applying Stringer's "denatured" video, including any alleged watermarks, would logically result in more wrapping of Bond's "unwatchable" video – teaching away from the claims. In fact, Bond's "unwatchable" data makes manipulations of *Stringer's denatured data including* the wrapping itself computationally infeasible. Last, no watermark as claimed herein and understood by one having ordinary skill in the art is taught, disclosed, or suggested by either reference. It is thus respectfully submitted that

there is no reasonable likelihood of success in combining these two citations, at least as suggested by the Office.

Last, a review of the Office Action makes clear that in each rejection, Bond and Stringer are relied upon for those elements that are present in the independent claims as well as the dependent claims. Because the cited citations, either alone or in combination fail to disclose all of the claim elements, the Office has failed to establish a prima facie case for obviousness for all claims that depend from Claims 6 and 20. See MPEP § 2143.03: "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). For at least this reason, the Office has failed to establish a prima facie case of obviousness for all claims that depend from Claims 6 and 20. See MPEP § 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious."). Accordingly, for at least these reasons, Applicant respectfully requests withdrawal of the Section 103 rejection for Claims 8, 11 and 13-21.

Appl'n No. 10/602,777

Amendment/Reply dated May 22, 2008

Reply to non-final Office Action of January 22, 2008

Conclusion


Applicant maintains that this application is in condition for allowance, and such disposition is earnestly solicited. Applicant's silence as to the Examiner's comments is not indicative of an acquiescence to the stated grounds of rejection. If the Examiner believes that an interview with the Applicant, either by telephone or in person, would further prosecution of this application, we would welcome the opportunity for such an interview.

It is believed that no other fees are required to ensure entry and consideration of this response.

Respectfully submitted,

Date: May 22, 2008

By:



Scott A. Moskowitz

Tel (305) 956-9041

Fax (305) 956-9042